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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,062	09/29/2003	Yeon-Kyoung Jung	1293.1968	4729

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STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

AULAKH, CHARANJIT

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 04/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/672,062

Applicant(s)

JUNG ET AL.

Examiner

Charanjit S. Aulakh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 26-28 and 31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☒ Claim(s) 29 and 30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. According to paper filed on Feb. 18, 2005, the applicants have elected group X with traverse in response to restriction requirement for further prosecution. Claims 26-28 and 31 are withdrawn from further consideration as being drawn to non-elected inventions.

2. Claims 1-25, 29 and 30 are now pending in the application.

Response to Arguments

3. Applicant's arguments filed on Feb. 18, 2005 regarding restriction requirement have been fully considered but they are not persuasive. The examiner does not agree with the applicants arguments that groups 1-20 do not represent independent and patentably distinct groups. As stated clearly in the last office action, the compounds of different groups 1-20 are structurally very divergent based on the values of variables n and R1 and therefore, lack a common core. Furthermore, the compounds of different groups are classified in numerous different classes and subclasses and therefore, constitute a burdensome search. It is of note that even the elected group X encompasses hundreds of thousands species of colorant compounds based on the values of variables R1, R2, R3, R4, R5, R6, X and the type of colorant used for coupling. Thus, restriction requirement as indicated is proper and thereby made final.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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5. Claims 1-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims are directed to preparing a light resistant colorant by coupling a colorant with compounds of formula (1). The specification mentions on page 4, [0018] that the light resistant colorant of present invention is formed by coupling a common colorant with compounds of formula (1) and further mentions that it may be obtained via the formation of an amine bond, an ester bond or an amide bond between hindered amine derivative and one or amino groups, hydroxyl groups, carboxyl groups, or sulfonic acid groups of a dye or a pigment. Therefore, based on these teachings, it is not clear whether all known common colorants in the art are dyes or pigments and furthermore, do all of them have amino groups, hydroxyl groups, carboxyl groups, or sulfonic acid groups? The specification does not teach any other mechanism for coupling instant compounds with common colorants. There is no teaching or guidance in the specification that how the instant compounds of formula (1) will impart light resistance to every known colorant irrespective whether it is a dye, pigment or something else? The specification mentions only few dyes and pigments as colorants and furthermore, does not teach whether all of these dyes and pigments have amino, hydroxyl, carboxyl or sulfonic acid groups. How about the colorants which do not have amino, hydroxyl, carboxyl or sulfonic acid groups? Are compounds of formula (1) well known in the art to be light resistant? What

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is the evidence that compounds of formula (1) are light resistant? The instant specification does not mention anything regarding light resistance of compounds of formula (1).

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1-25, the colorant used to couple with compounds of formula (1) and the light resistant colorant obtained are not defined and furthermore, it is not clear how the specific colorant and compounds of formula (1) are being coupled? Also, the term – material—is indefinite since it is not clear whether it means compounds of formula (1) or some sort of material (such as cloth, wood etc.)comprising compounds of formula (1).

8. Claims 1-25 are objected for containing non-elected subject matter.

Allowable Subject Matter

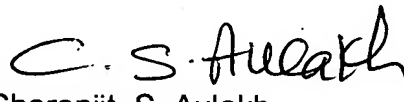
9. Claims 29 and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charanjit S. Aulakh whose telephone number is (571)272-0678. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on (571)272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Charanjit S. Aulakh
Primary Examiner
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